

REMARKS

In the Office Action, the Examiner provided an objection based under 35 U.S.C. §132, rejected claims 1, 2, 4-17, 25, 27, and 29 under 35 U.S.C. §112 (first paragraph), rejected claims 2 and 4-17 under 35 U.S.C. §112 (second paragraph), rejected claims 1, and 25-29 under 35 U.S.C. §102(b) as being anticipated by Moniz (U.S. Patent Number 5,288,491, hereinafter “Moniz”), and rejected claims 1, 2, and 4-29 under 35 U.S.C. §103(a) as being unpatentable over Kondo (Japanese Patent Number JA 200095663A, machine translation, hereinafter “Kondo”) in view of Duffy et al. (U.S. Patent Number 5,472,699, hereinafter “Duffy”). Accordingly, Applicant provides the following remarks:

Objection under 35 U.S.C. §132

In the Office Action, the Examiner provided an objection based under 35 U.S.C. §132, indicating that “the statement that the present invention uses extracts and concentrated extracts from several various parts of the Indian Mulberry or Morinda citrifolia plant (‘noni’), such as the leaves, bark, roots, and other parts of the plant, while the fruit juice and oil are ‘preferably’ used ... is inconsistent with applicants’ original disclosure...” Accordingly, Applicant respectfully cancels herein any new matter and provides an amendment to the disclosure to overcome the objection. Therefore, Applicant respectfully submits that the objection under 35 U.S.C. §132 has been overcome.

Rejection under 35 U.S.C. §112

In the Office Action, the Examiner rejected claims 1, 2, 4-17, 25, 27, and 29 under 35 U.S.C. §112 (first paragraph) and rejected claims 2 and 4-17 under 35 U.S.C. §112 (second paragraph). Regarding the rejections made under 35 U.S.C. §112 (first paragraph), Applicant respectfully submits that the application complies with 35 U.S.C. §112 (first paragraph). The amendments

provided herein to the claims provide a limitation of fruit juice and, as indicated by the Examiner “...the original specification discloses the processing of noni fruit juice ...” Accordingly, Applicant respectfully submits that all rejections made under 35 U.S.C. §112 (first paragraph) have been overcome by the amendments included herein. Regarding the rejections made under 35 U.S.C. §112 (second paragraph), Applicant respectfully submits that the amendments made herein to the claim set correct all indefiniteness, vagueness, and insufficient antecedent basis that were the basis for the rejections made by the Examiner under 35 U.S.C. §112 (second paragraph). Accordingly, Applicant respectfully submits that the rejections under 35 U.S.C. §112 (second paragraph) have been overcome by the amendments included herein.

Rejection under 35 U.S.C. §102(b)

In the Office Action, the Examiner rejected claims 1, and 25-29 under 35 U.S.C. §102(b) as being anticipated by Moniz. Moniz discloses a “method for processing the noni plant into powder, [that] includes the steps of picking the noni fruit from the tree, placing picked noni fruit in a room, washing and cleaning the noni plant, mashing the noni fruit, placing the pulp onto liner, rotating trays for five hours, rotating trays for another five hours, rotating trays for another 14 hours, and crushing and grinding dried wafers.” (Abstract) Claim 1 includes a limitation of using a quantity of Proxeronase to activate a release of Xeronine, which is not taught by Moniz. And, since Moniz does not teach or disclose each and every limitation of claim 1, claim 1 as amended overcomes the rejection made by the Examiner under 35 U.S.C. §102(b) for at least this reason. Claim 25 includes a limitation of providing said cosmetic skin toner composition to hydrate the skin, which is not taught by Moniz. And, since Moniz does not teach or disclose each and every limitation of claim 25, claim 25 as amended overcomes the rejection made by the Examiner under 35 U.S.C. §102(b) for at least this reason. Claim 26 includes a limitation of providing said cosmetic skin toner

composition to balance pH levels in the skin, which is not taught by Moniz. And, since Moniz does not teach or disclose each and every limitation of claim 26, claim 26 as amended overcomes the rejection made by the Examiner under 35 U.S.C. §102(b) for at least this reason. Claim 27 includes a limitation of providing said composition to balance pH levels in the skin, which is not taught by Moniz. And, since Moniz does not teach or disclose each and every limitation of claim 27, claim 27 as amended overcomes the rejection made by the Examiner under 35 U.S.C. §102(b) for at least this reason. Claim 28 includes a limitation of providing said composition to hydrate the skin, which is not taught by Moniz. And, since Moniz does not teach or disclose each and every limitation of claim 28, claim 28 as amended overcomes the rejection made by the Examiner under 35 U.S.C. §102(b) for at least this reason. Claim 29 has been cancelled. Accordingly, Applicant respectfully submits that the rejections under 35 U.S.C. §102(b) have been overcome by the amendments included herein.

Rejection under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 1, 2, and 4-29 under 35 U.S.C. §103(a) as being unpatentable over Kondo in view of Duffy. Kondo specifically provides, "In this invention, the vegetable extract used as an active principle is prepared by extracting from the sheet / branch and the trunk / bark / bloom / fruits / roots, or those dry matters of the above-mentioned vegetation using a suitable extracting solvent." (See [0013]) In contrast, the present invention uses pure/unmodified fruit juice from the *Morinda citrifolia*. Applicant respectfully submits that the use of an extracting solvent can cause beneficial constituents to be lost. Further, the Examiner provided, "While the example composition in Kondo contains the bark extract of noni, examiner takes the position it would have been obvious to a skilled artisan that other parts of the same plant would inherently provide the same effects." Applicant respectfully disagrees and uses Moniz to provide

documentation to the contrary. For example, Moniz teaches that the bark has been used as a red dye, the root has been used as a yellow dye, an oil of the fruit has been used to treat hair, the plant has been used as a poultice, and the leaves have been used to treat diarrhea, menstrual problems and fever. Accordingly, the position that it would have been obvious to a skilled artisan that other parts of the same plant would inherently provide the same effects is erroneous. Thus, for at least these reasons, Applicant respectfully submits that Kondo is an improper 35 U.S.C. §103(a) reference. And, if Kondo is an improper reference, any reference in combination with Kondo is also improper. Accordingly, Applicant respectfully submits that the claims as provided herein overcome all rejections made in the Office Action by the Examiner.

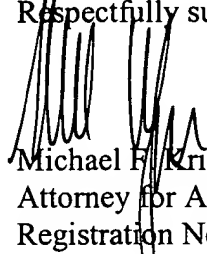
9/1

CONCLUSION

Applicant believes the application to now be in condition for allowance and respectfully requests the same. in the event there remains any impediment to allowance of the claims that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

DATED this 21 day of August, 2002.

Respectfully submitted,



Michael F. Krieger
Attorney for Applicant
Registration No. 35,232

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 328-3600
Facsimile: (801) 321-4893

DBT:je
627478.1



COPY OF PAPERS
ORIGINALY FILED

VERSION TO SHOW CHANGES MADE

IN THE DISCLOSURE:

Please amend the title of the application to:

[*MORINDA CITRIFOLIA*] METHODS FOR MANUFACTURING AN ENHANCED COSMETIC
SKIN CARE TONER

Applicants respectfully request cancellation of the amendments made to the paragraph on page 18 in the reply dated February 8, 2002. The paragraph begins on line 10 of the clean version of the replacement specification and begins on line 21 of the marked up version of the replacement specification. Furthermore, Applicants respectfully request that the paragraph be amended as follows:

[The present invention utilizes the fruit juice and the oil extracted from the *Morinda Citrifolia* plant.] In a currently preferred process of producing *Morinda* [*c*] *Citrifolia* fruit juice, the fruit is either hand picked or picked by mechanical equipment. The fruit can be harvested when it is at least one inch (2-3 cm) and up to 12 inches (24-36 cm) in diameter. The fruit preferably has a color ranging from a dark green through a yellow-green up to a white color, and gradations of color in between. The fruit is thoroughly cleaned after harvesting and before any processing occurs.

IN THE CLAIMS:

Applicants respectfully request the cancellation and amendment of the claims as set forth below. (A version to show the changes made is provided herein.)

1. A method for providing a topical cosmetic skin toner composition that may [designed to] be spread on [the] skin to hydrate and balance pH levels in said skin, said [composition] method comprising the steps for:

providing pure *Morinda Citrifolia* fruit juice, wherein said fruit juice includes Proxeronine

[present in an amount between about 0.001-80 percent by weight];

combining said fruit juice with a cosmetically suitable carrier agent to provide said topical

cosmetic skin toner composition that may be spread on said skin to hydrate and

balance pH levels in said skin; and

using a quantity of Proxeronase to activate [the] a release of Xeronine, [from said

Proxeronine, said Proxeronase also capable of activating the release of Xeronine

from any Proxeronine present in said skin,] said Xeronine capable of enhancing and

improving cellular vitality in said skin[; and

a cosmetically suitable carrier agent].

2. The [topical cosmetic skin toner composition] method of claim 1, wherein said release of Xeronine occurs from one of:

(i) said Proxeronase in said fruit juice; and [is in processed *Morinda citrifolia* present in an amount between about 10-80 percent by weight.]

(ii) Proxeronase present in said skin.

3. (Cancelled previously)

4. The [topical cosmetic skin toner composition] method of claim [2] 1, wherein said *Morinda citrifolia* fruit juice is present in said topical cosmetic skin toner composition in an amount between [about] 10-15 percent by weight.

5. The [topical cosmetic skin toner composition] method of claim [2] 1, wherein said *Morinda citrifolia* fruit juice is present in said topical cosmetic skin toner composition in an amount between [about] 15-20 percent by weight.

6. The [topical cosmetic skin toner composition] method of claim [2] 1, wherein said *Morinda citrifolia* fruit juice is present in said topical cosmetic skin toner composition in an amount between [about] 20-25 percent by weight.

7. The [topical cosmetic skin toner composition] method of claim [2] 1, wherein said *Morinda citrifolia* fruit juice is present in said topical cosmetic skin toner composition in an amount between [about] 25-30 percent by weight.

8. The [topical cosmetic skin toner composition] method of claim [2] 1, wherein said *Morinda citrifolia* fruit juice is present in said topical cosmetic skin toner composition in an amount between [about] 30-35 percent by weight.

9. The [topical cosmetic skin toner composition] method of claim [2] 1, wherein said *Morinda citrifolia* fruit juice is present in said topical cosmetic skin toner composition in an amount between [about] 35-40 percent by weight.

10. The [topical cosmetic skin toner composition] method of claim [2] 1, wherein said *Morinda citrifolia* fruit juice is present in said topical cosmetic skin toner composition in an amount between [about] 40-45 percent by weight.

11. The [topical cosmetic skin toner composition] method of claim [2] 1, wherein said *Morinda citrifolia* fruit juice is present in said topical cosmetic skin toner composition in an amount between [about] 45-50 percent by weight.

12. The [topical cosmetic skin toner composition] method of claim [2] 1, wherein said *Morinda citrifolia* fruit juice is present in said topical cosmetic skin toner composition in an amount between [about] 50-55 percent by weight.

13. The [topical cosmetic skin toner composition] method of claim [2] 1, wherein said *Morinda citrifolia* fruit juice is present in said topical cosmetic skin toner composition in an amount between [about] 55-60 percent by weight.

14. The [topical cosmetic skin toner composition] method of claim [2] 1, wherein said *Morinda citrifolia* fruit juice is present in said topical cosmetic skin toner composition in an amount between [about] 60-65 percent by weight.

15. The [topical cosmetic skin toner composition] method of claim [2] 1, wherein said *Morinda citrifolia* fruit juice is present in said topical cosmetic skin toner composition in an amount between [about] 65-70 percent by weight.

16. The [topical cosmetic skin toner composition] method of claim [2] 1, wherein said *Morinda citrifolia* fruit juice is present in said topical cosmetic skin toner composition in an amount between [about] 70-75 percent by weight.

17. The [topical cosmetic skin toner composition] method of claim [2] 1, wherein said *Morinda citrifolia* fruit juice is present in said topical cosmetic skin toner composition in an amount between [about] 75-80 percent by weight.

18. The [topical cosmetic skin toner composition] method of claim [2] 1, further comprising the step for combining water in said topical cosmetic skin toner composition, wherein said water is present in an amount between about 20-80 percent by weight.

19. The [topical cosmetic skin toner composition] method of claim [2]_1, further comprising the step for combining one or more additional ingredients into said topical cosmetic skin toner composition, wherein said one or more additional ingredients are selected from the group consisting of glycerin, alcohol denatured, butylene glycol, sodium chloride, dipotassium phosphate, sodium citrate, panthenol (pro-vitamin B5), diazolidinyl urea, PPG-26-Buteth-26, benzophenone-4, citric acid, disodium EDTA, potassium phosphate, PEG-40 hydrogenated castor extract, capryloyl salicylic acid (beta-hydroxy acid), fragrance, PEG-115M, cabbage rose water, FD & C Red No. 4, and D&C Red No. 33.

20. The [topical cosmetic skin toner composition] method of claim [2]_1, further comprising the step for combining one or more additional ingredients into said topical cosmetic skin toner composition, wherein said one or more additional ingredients are selected from the group consisting of alcohol denatured, butylene glycol, glycerin, silica dimethyl silylate, zinc oxide, propylene glycol, PEG-60 hydrogenated castor extract, methylparaben, lactic acid, grapefruit extract, fragrance, menthoxypropanediol, hexylene glycol, and witch hazel.

21. The [topical cosmetic skin toner composition] method of claim [2]_1, further comprising the step for combining one or more additional ingredients into said topical cosmetic skin toner composition, wherein said one or more additional ingredients are selected from the group consisting of SD alcohol 40, witch hazel distillate, PEG-40, hydrogenated castor oil, fragrance, aloe vera gel, allantoin, menthyl lactate, sorbitol, sodium lactate, proline, sodium PCA, hydrolyzed collagen, FD&C Blue No. 1, and FD&C Yellow No. 5.

22. The [topical cosmetic skin toner composition] method of claim [2]_1, further comprising the step for combining one or more additional ingredients into said topical cosmetic skin toner composition, wherein said one or more additional ingredients are selected from the group consisting of glycerin, PEG-8, PEG-40, hydrogenated castor oil, polyaminopropyl biguanide, panthenol, niacinamide, aloe barbadensis gel, matricaria (Chamomilla Recutita) extract, propylene glycol, polyquaternium-10, ethoxydiglycol, fragrance, EDTA, sodium hydroxide, and methylparaben.

23. The [topical cosmetic skin toner composition] method of claim [2]_1, further comprising the step for combining one or more additional ingredients into said topical cosmetic skin toner composition, wherein said one or more additional ingredients are selected from the group consisting of SD alcohol 40-B, dipropylene glycol, witch hazel (Hamamelis Virfiniana) distillate, hops (Humulus lupulus) extract, rosemary (Rosmarinus Officinalis) extract, swertia japonica extract, tocopheryl acetate (vitamin E Acetate), panthenol, aloe barbadensis extract, pyridoxine HCL, farnesol, salicylic acid, menthol, glycerin, fragrance, butylene glycol, and sodium hydroxide.

24. The [topical cosmetic skin toner composition] method of claim [2]_1, further comprising the step for combining one or more additional ingredients into said topical cosmetic skin toner composition, wherein said one or more additional ingredients are selected from the group consisting of SD alcohol 40-B, witch hazel distillate, menthol, aloe barbadensis extract, glycerin, diglycerin, eucalyptus globulus oil, fragrance, butylene glycol, PG, Ext. Violet 2, and green 5.

25. A method for hydrating skin, [topical cosmetic skin toner composition] said method comprising the steps for:

providing pure *Morinda citrifolia* fruit juice [oil present in an amount between about 10-80 percent by weight]; [and]

combining said pure fruit juice with a cosmetically suitable carrier agent to provide a topical cosmetic skin toner composition, [said composition designed] wherein said pure fruit juice is present in an amount between about 10-80 percent by weight; and

providing said cosmetic skin toner composition to hydrate [and balance pH levels in] the skin.

26. A method for balancing pH levels in skin, [topical cosmetic skin toner composition] said method comprising the steps for:

providing pure *Morinda citrifolia* fruit juice[present in an amount between about 10-80 percent by weight]; [and]

combining said pure fruit juice with a cosmetically suitable carrier to provide a topical cosmetic skin toner composition, [said composition operating] wherein said pure fruit juice is present in an amount between about 10-80 percent by weight; and

proving said cosmetic skin toner composition to balance pH levels in the skin.

27. A method for balancing pH levels in skin. [topical cosmetic balancing skin toner composition] the method comprising the steps for:

providing pure *Morinda citrifolia* fruit juice [oil present in an amount between about 10-80 percent by weight];

providing a balancing agent; [and]

combining said fruit juice and said balancing agent with a cosmetically suitable carrier to create a topical cosmetic skin toner composition; and[,]

providing said composition [operating] to balance pH levels in the skin.

28. A method for hydrating skin. [topical cosmetic hydrating skin toner composition] the method comprising the steps for:

providing pure *Morinda citrifolia* fruit juice [present in an amount between about 10-80 percent by weight];

providing a hydrating agent; [and]

combining said fruit juice and said hydrating agent with a [cosmetically suitable] carrier[,]
agent to create a topical cosmetic hydrating skin toner composition; and

providing said composition [operating] to hydrate the skin.

29. (Cancel)